

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

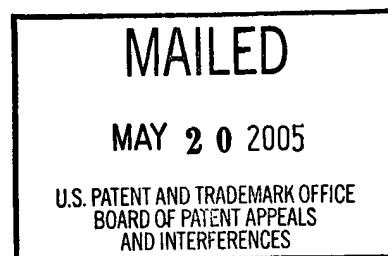
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JURG ZIMMERMANN,
HANS-GEORG CAPRARO,
PATRICIA IMBACH, and
PASCAL FURET

Appeal No. 2002-7495
Application No. 09/051,827

ON BRIEF



Before WILLIAM F. SMITH, GRIMES, and GREEN, Administrative Patent Judges.¹

GRIMES, Administrative Patent Judge.

REQUEST FOR REHEARING

The Deputy Commissioner for Patent Examination Policy (Deputy Commissioner) requests rehearing of the board's decision entered September 11, 2003. See Paper No. 19, entered into the record February 27, 2004. Appellants were provided a copy of the Request for Rehearing and given a one-month period in which to respond. See Paper No. 20, mailed July 21, 2004 and re-mailed August 18, 2004. Appellants did not respond to the Request for Rehearing.

¹ The merits panel that issued the initial decision in this appeal included Administrative Patent Judge Sherman D. Winters, who has since retired from the USPTO. APJ Grimes has replaced APJ Winters on this panel. See In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

In our previous decision, we affirmed the rejection of claim 2 because the specification failed to adequately describe “the subject matter now claimed where variable R_4 is an aliphatic hydrocarbon radical having not more than 29 carbon atoms which may be substituted, inter alia, by ‘mercapto.’” Paper No. 17, mailed September 11, 2003, page 7. However, we reversed the same rejection as applied to claim 3 because “in claim 3, R_4 is hydrogen. . . . In other words, claim 3 does not include the very recitation which gives rise to the examiner’s rejection.” Id., page 8.

The Deputy Commissioner requests that we reconsider our reversal of the rejection of claim 3. See Paper No. 19, pages 3-4:

The Board reversed with regard to Claim 3, pointing out, correctly, that claim 3 says, “ $R_4 = H$ ”. The problem is, the Board overlooked R_5 , whose definition is linked to R_4 in independent claim 2. The independent claim says, “ R_5 independently of R_4 , is as defined above for R_4 , with the exception of hydrogen and an aliphatic hydrocarbon radical having not more than 29C atoms, which is substituted by hydroxyl. . .”. Thus, claim 3 limited R_4 , **but did not limit R_5** , since the definitions are independent. . . . Thus this claim has the same new matter problem regarding mercapto as independent claim 2.

(Emphasis in original.) The Deputy Commissioner concludes that if we “complet[e] the analysis of claim 3, taking into account the definition of R_5 , the Board should clearly see that the reversal of the new matter rejection of claim 3 is factually incorrect.” Id., page 4.

On reconsideration, we agree with the Deputy Commissioner that our reversal of the rejection of claim 3 was based on a factual error. As the request for rehearing points out, the definition of R_5 in claim 3 includes the same problematic limitation as the definition of R_4 in claim 2. That is, claim 3 further limits the definition of R_4 that is set out in claim 2, but does not further limit the definition of R_5 ; since the definition of R_5 in claim 2 includes “an aliphatic hydrocarbon radical having not more than 29 C atoms, which is

substituted by . . . mercapto," claim 3 lacks an adequate written description in the specification for the same reason that claim 2 does.

The Deputy Commissioner's request for rehearing is granted. The rejection of claim 3 under 35 U.S.C. § 112, first paragraph, is affirmed.

REHEARING GRANTED


William F. Smith

Administrative Patent Judge


Eric Grimes

Administrative Patent Judge


Lora M. Green

Administrative Patent Judge

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Appeal No. 2002-1475
Application No. 09/051,827

Page 4

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